



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,540	02/09/2000	Michael D. Hitchcock	P-01800-US1	3996
25784	7590	01/27/2006	EXAMINER	
MICHAEL O. SCHEINBERG P.O. BOX 164140 AUSTIN, TX 78716-4140			VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

E

<b>Office Action Summary</b>	<b>Application No.</b> 09/501,540	<b>Applicant(s)</b> HITCHOCK ET AL.	
	<b>Examiner</b> Gregory J. Vaughn	<b>Art Unit</b> 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Application History*

1. This action is responsive to the Request for Continued Examination, filed on 6/21/2004.
2. Applicant has cancelled claims 1-27 and added new claims 28-38.
3. Claims 28-38 are pending in the case, claim 28 is an independent claim.
4. A request for continued examination filed under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after a final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action (dated 2/24/2004) has been withdrawn pursuant to 37 CFR 1.114.
5. Examiner's rejection of claims 25-27, made under 35 USC 112 in the *Claim Rejections – 35 USC 112* section of the previous office action (dated 2/24/2004) is withdrawn in view of the cancelled claim.
6. Examiner's rejection of claims 1-27, made under 35 USC 102 or 35 USC 103, as recited in the previous office action (dated 2/24/2004) are withdrawn in view of the cancelled claims.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."*

8. Claims 28 and 30-37 are rejected under 35 USC 103(a) as being unpatentable over Wang et al. US Patent 5,490,217, filed 3/5/1993, patented 2/6/1996 (hereinafter "*Wang*") in view Tamaro US Patent Publication US2001/0011246A1, filed 8/10/98, published 8/2/2001, and in further view of Webster's II New College Dictionary (published in 1995).

9. **Regarding independent claim 28**, Wang describes automatically generating a request bearing a machine readable code (shown as reference sign 16 in Figs. 5, 7-10, and at column 3, lines 6-16) which describes that the "*machine readable image code*" contains "*instructions as to how the document is to be handled*" and may include the "*generating of additional paper documents*" and human readable information (see Figs. 7-12, and at column 2, lines 61-67, and column 7, lines 62-67) which describes that the information content is available in human readable form; and receiving from the third party as facsimile data both the document requested and the request (at column 4, lines 54-65), which describes that when retrieving a document,

the encoder will *"encode the index/annotation and other identification/content information"* and *"prepare and/or print the document combined with the machine readable image code"* and that the *"form can be sent over the fax machine"*.

Wang further anticipates *"automatically determining from the facsimile data the identifying information and associating the facsimile data with the application, whereby the third party uses only a facsimile transmission device to transmit the document in electronic form and the machine readable identifying information facilitates automatic matching of the document with the application at the institution."* Wang discloses at column 2, line 7, that an object of the present invention is to *"provide a system for relating documents to an identified entity"*. Wang discloses an automatic interpreter (described as a *"decoder"*) (column 4, line 3) that associates a new document to an existing document (described as *"machine readable image code which image code encodes identifying content"*) (Column 2, line 30) *"for relating documents to an identified entity"* (column 2, line 7) by *"fax communications"* (see figures 1 and 2).

Wang discloses *"document"*, but fails to disclose *"applications for admissions to institutions"*. However, Tammaro discloses a system for transmitting an application to an institution (paragraph 26). Tammaro teaches that institution applications can be transmitted by a system.

Although, Wang discloses *"transmitting"* and *"receiving"*, Wang fails to identify who the application is transmitted to and received from. However,

Art Unit: 2178

Webster's definition of an "*applicant*" reads (page 55) "*One who applies, as for a job or admission.*" Webster's teaches that the intended user of an application is an "applicant".

Therefore, it would have been obvious to one of ordinary skill in the art, having Wang's automatic document handling system and the teachings of Tammaro and Webster's at the time the invention was made to modify Wang's automatic document handling method to provide a method for the transmission and reception of electronic applications for institution.

10. **Regarding dependent claims 30 and 31**, Wang discloses the identifying information in the form of a bar code or of alphanumeric characters (column 1, lines 50-59).
11. **Regarding dependent claim 32**, Wang discloses transmitting an electronic application form in Figure 3 (shown as "*Transmit it through computer network*"), and a method for storing a file in facsimile format (described as "*FAX*") (see figure 3) and associating the file to an applicant (described as "*relating documents to an identified entity*") (column 2, line 7).
12. **Regarding dependent claim 33**, Wang, Tammaro, and Webster's disclose transmitting an application form to an applicant, receiving the application form with applicant entered information, associating the application with stored information, and transmitting the stored document as described above. Wang discloses transmitting a second electronic application

Art Unit: 2178

form. Wang recites: "*the generating of additional paper documents*" (column 3, lines 14-15).

13. **Regarding dependent claim 34**, Tammaro discloses verifying that the third party (described as "*finance source*") is participating in the transmission program (see figure 2, reference 112 and 116), and transmission by facsimile (page 1, paragraph 7).
14. **Regarding dependent claim 35**, Tammaro discloses verifying if the institution (described as "*finance source*") is participating in the transmission program (see figure 2, references 112 and 116).
15. **Regarding dependent claims 36 and 37**, Wang discloses a method of transmitting documents (column 3, lines 2-3) and "*all kinds of business transaction forms*" (column 6, line 26).
16. Claims 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Tammaro and Webster's, further in view of Mowry et al., U.S. Patent 5,853,197 (patented 12/29/98).
17. **Regarding dependent claim 29**, Wang discloses "*document*" but fails to disclose "*transcripts*". However, Mowry discloses a document management system that uses machine-readable coding that can be used for processing a "*college transcript*" at column 1 line 14.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add "transcripts" to the inventions of

Art Unit: 2178

Wang and Tammaro to provide a method for requesting and receiving transcripts by facsimile.

18. Dependent claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Tammaro and Webster's, further in view of MacPhail, U.S. Patent 5,089,956 (patented 2/18/92).

19. **Regarding dependent claim 38**, Wang and Tammaro fail to disclose transmission timing in the Automatic Document Handling System invention, but MacPhail discloses an "*after*" event timing of document transmission in column 3, line 49. MacPhail discloses the following: "*After the dialog manager application has gathered the above-identified information, it transmits the information ...*"

Therefore, it would have been obvious to one of ordinary skill in the art, having Wang's automatic document handling system, Tammaro's auto credit application system and the teaching of MacPhail, at the time the invention was made, to incorporate event timing of transmission of documents into the automated document handling system to achieve a system that can manage associated documents where the documents are to be processed at different times.



***Response to Arguments***

20. Applicant's amendment of 6/21/2004 has canceled pre-existing claims 1-27, and added new claims 28-38. Applicant's remarks do not include arguments.
21. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

***Conclusion***

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory J. Vaughn  
January 17, 2006

**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**